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10/803,360	03/18/2004	James Kevin Gillie	A1019-20354	5836
3000 7590 02/26/2007 CAESAR, RIVISE, BERNSTEIN, COHEN & POKOTILOW, LTD. 11TH FLOOR, SEVEN PENN CENTER 1635 MARKET STREET PHILADELPHIA, PA 19103-2212			EXAMINER TRAN, THAO T	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/803,360
Filing Date: March 18, 2004
Appellant(s): GILLIE, JAMES KEVIN

**MAILED
FEB 26 2007
GROUP 1700**

Martin L. Faigus
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/18/2006 appealing from the Office action mailed 11/30/2005..

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. The examiner has inadvertently not mentioned that Applicants' Response after final filed on 1/19/2006 has been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,824,394	KINOSHITA et al.	10-1998
4,525,419	POSEY et al.	6-1985

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinoshita et al. (US Pat. 5,824,394) in view of Posey et al. (US Pat. 4,525,419).

Kinoshita teaches a printable laminate, comprising a biaxially oriented polyester film comprising polypropylene (in layer B) and a coating comprising urethane-based resin (see abstract; col. 2, ln. 33-43; col. 9, ln. 28-35; Example 6). The urethane-based resin is water soluble, containing an acrylic-based polyol and a crosslinking agent, such as aziridine, and an antiblock agent (see col. 7, ln. 7-17, 33; col. 8, ln. 24-35). The polyester film may be surface treated with chemical or discharge (oxidative) treatment before coating and after stretching in the machine direction (see col. 9, ln. 62-67), showing that coating is between the machine direction orientation and the transverse direction orientation. The polyester film further comprises an antiblock agent (slip agent) such as silica in an amount of 0.1% (see col. 15, ln. 34-37).

Moreover, it is hereby noted that although Kinoshita teaches the same steps of stretching of the film as presently claimed, it is the structural elements that impart patentability to an article claim, and not how the layers are made.

Art Unit: 1711

In regards to claims 1-6, 8, 11-17, and 21-24, Kinoshita differs from the presently claimed invention because the reference does not teach the base film to be predominantly polypropylene.

Posey discloses a printable laminate, wherein the base film is an oriented plastic film made of polyester or polypropylene (see col. 3, ln. 25-30). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have employed the polypropylene film, as taught by Posey, as the base film in Kinoshita. By teaching polypropylene as an equivalent of polyester base film, Posey directly teaches that the use of one in substitute for another would have yielded the same results.

In regards to claim 7, Kinoshita teaches that the coating layer contains acrylic-based resin or urethane-based resin (see abstract). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine these two resins because it has been held obvious that combining two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. See MPEP 2144.06.

In regards to claims 9-10, 12, although Kinoshita does not specify the amount of the antiblock agent or the crosslinking agent in the coating layer, since Kinoshita teaches that the amount of the antiblock agent or the crosslinking agent in the polyester film is 0.1%, it would have been obvious that the amounts of these agents in the coating layer would be the same as that in the polyester film, in order to have the layers more compatible with each other in terms of crosslinking and/or antiblocking. Moreover, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, that the concentration of a compound would have

Art Unit: 1711

been determined by routine experimentation in order to achieve the desired results, such as crosslinking and/or antiblocking.

In regards to claims 18-20, although Kinoshita does not specifically teach the polypropylene to be a homopolymer, copolymer, or a combination thereof, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, that the polypropylene would have been one of these three possibilities, and the use of them would have given the same results since they are alternative of each other as disclosed in the present specification. Moreover, it has been within the skill in the art that the selection of a known material based on its suitability for its intended use would have been obviousness determination. See MPEP 2144.06, 2144.07.

(10) Response to Argument

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Posey is used to illustrate that an oriented base film made of polypropylene or polyester has been conventionally taught in the prior art of printable laminates. By teaching polypropylene and polyester base films as alternatives of each other, Posey directly teaches that the use of one in substitute of the other would have yielded the same results. Thus, Posey is used to remedy Kinoshita and the combination of the references is proper.

Art Unit: 1711

Moreover, with respect to Applicants' argument on page 6, 2nd paragraph, of the Appeal Brief that the presently claimed invention is directed to the urethane coating formed from a urethane dispersions or waterborn, urethane dispersions blended with waterborne acrylic dispersions, it is noted that the claim language does not include what type of urethane is used. Moreover, in an article claim, it is the end product, in this case the urethane coating, would impart patentable weight, not whether it comes from a dispersion or a waterborn solution.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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02/02/2007S

Conferees:


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PRIMARY EXAMINER

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